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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/991,679	11/26/2001	Steven Parker	WH 11 264-1US	4166

24962 7590 12/20/2005

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EXAMINER

PAULA, CESAR B

ART UNIT	PAPER NUMBER
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2178

DATE MAILED: 12/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/991,679	Applicant(s) PARKER ET AL.	
	Examiner CESAR B. PAULA	Art Unit 2178	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 26-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 26-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to the RCE amendment filed on 10/7/2005.

This action is made Non-Final.

2. In the amendment, claims 1-6, 9-25 have been canceled. Claims 26-38 have been added. Claims 26-38 are pending in the case. Claims 26, and 33 are independent claims.

Priority

3. It is noted, that applicant has not filed certified copies of the Canadian application number 2,351,780 as required by 35 U.S.C. 119(b). Therefore, the priority claim has been denied.

Drawings

4. The drawings filed on 11/26/2001 have been approved by the examiner.

Claim Objections

5. Claim 32 is objected to because of the following informalities: The claim depends on canceled claim 21. Appropriate correction is required.
6. Claim 33 is objected to because of the following informalities: The claims recites "authorization step to delivery of the prepared business communication" in lines 21-22. This

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sentence is better written as “authorization step for delivery of the prepared business communication” Appropriate correction is required.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 30-31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

9. Claim 30 recites the limitation "said account specific business information" in line 2. There is insufficient antecedent basis for this limitation in the claim. There is no previous "account specific business information" in this claim or base claim 29 to refer to.

10. Claim 31 recites the limitation "said delivery service". There is insufficient antecedent basis for this limitation in the claim. There is no previous "delivery service" in this claim or its base claim(s) to refer to.

Claim Rejections - 35 USC § 102

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

12. Claims 26-27, 32-33, and 38 are rejected under 35 U.S.C. 102(e) as being anticipated by Gropper (Pat.# 6,883,000, 4/19/2005, filed on 2/12/1999),

Regarding independent claim 26, Gropper discloses a business subscriber conveying business card contact, and advertising information to a server over a public network, such as the Internet. The information includes data such as name, company logo, ads, business card recipient contact information, etc.-- *a web server, said web server including an arrangement for establishing separate accounts for business; means for uploading and storing on said web server for future account usage account specific business information including graphic images, specific text messages, marketing communications associated with wares or services of the business, and identification of clients including identification and, contact personalized printed business browser over the internet information--*(col.3, lines 40-col.4, lines 1-67, col.13, lines 51-67, fig.2-D, fig.3,15).

Moreover, Gropper discloses allowing users to access the business information using passwords-- *said web server further including means for establishing for each account authorized users of the specific account--*(col.8, lines 1-35).

Moreover, Gropper discloses the use of the information for printing a two-sided business card having the business information, which also includes a personal expression—"We make banking simple again--", found on the server-- *said web server including a browser based business card preparation procedure for any authorized user of a specific account, said*

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procedure including the authorized user preparing a personalized business communication having specific panels by selecting account specific business information for specific panels of the personalized business communication based on the uploaded and stored account specific business information in combination with a personal expression entered by the authorized user --(col.35 lines 21-col.36, line 29, fig.2-D, fig.15).

Moreover, Gropper discloses users access the business information located in the server—"We make banking simple again"--, found on the server-- *said preparation procedure further including user specified clients to receive the personalized business communication from the identified clients associated with the specific account and a user executed step to complete the prepared personalized business communication --(col.8 lines 1-35, col.11, lines 1-34, fig.2-D, fig.15).*

Furthermore, Gropper discloses users access the business information located in the server, and print the business cards(col.11, lines 1-34, col.35 lines 16-43, fig.15). In other words, the card information is printed and delivered from the server to the printer-- *said web server cooperating with a printing and delivery arrangement to print and deliver the printed personalized business communication to the specified clients.*

Regarding claim 27, which depends on claim 26, Gropper discloses an event log file for tracking the performance of the client computer (col.25, lines 1-12).

Regarding claim 32, which depends on claim 21, Gropper discloses storing an UCL-- *signature*, which can be an email address, along with the card information on the server. The

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UCL is printed of the card, and can be used for accessing the information stored on the server (col.4, lines 43-67).

Claim 33 is directed towards a method for implementing the system found in claim 26, and therefore is similarly rejected.

Regarding claim 38, which depends on claim 33, Gropper discloses placing personal statement, such as the motto "We make banking simple again" only on the front side of the card - (col.8 lines 1-35, col.11, lines 1-34, fig.2-D, fig.15).

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 28-31, and 34-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gropper, in view of Endo et al, hereinafter Endo (USPub. # 2002/0022989, filed on 2/21/2002, filed on 2/22/2002).

Regarding claim 28, which depends on claim 26, Gropper discloses the use of the information for printing a two-sided business card having the business information, which also

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includes a personal expression (col.35 lines 21-col.36, line 29, fig.2-D, fig.15). Gropper fails to explicitly disclose: *three panel card where each panel includes a front surface and a rear surface*. However, Endo teaches sending a coupon attached, in the lower half of the back portion of the card which has two sides, each side having two divisions—*panels*—split down the middle of the card, to the greeting card for a free trial of a new song (0054, and 0137, 0141-0144, fig.27). It would have been obvious to a person of ordinary skill in the art at the time of the invention to combine Gropper, and Endo, because Endo teaches the benefit of improving the publication effect of businesses, while providing greeting cards at no cost to a sender (0005-0006).

Regarding claim 29, which depends on claim 28, Gropper discloses a UCL, which is conveyed to a recipient via various communication means (col.10, lines 57-67). Gropper fails to explicitly disclose: *one of said surfaces is an address surface receiving client delivery information and one of said surfaces includes said personal expression*. However, Endo teaches sending an address for the recipient of the coupon, which is located in the upper half of the front of the card (0054, and 0137, 0141-0144, fig.27). It would have been obvious to a person of ordinary skill in the art at the time of the invention to combine Gropper, and Endo, because Endo teaches the benefit of improving the publication effect of businesses, while providing greeting cards at no cost to a sender (0005-0006).

Regarding claim 30, which depends on claim 29, Gropper discloses a UCL, which is conveyed to a recipient via various communication means (col.10, lines 57-67). Gropper fails to

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explicitly disclose: *four of said account specific business information*. However, Endo teaches the card having information regarding a music ad on all of 4 panels (0054, and 0137, 0141-0144, fig.27). It would have been obvious to a person of ordinary skill in the art at the time of the invention to combine Gropper, and Endo; because Endo teaches the benefit of improving the publication effect of businesses, while providing greeting cards at no cost to a sender (0005-0006).

Regarding claim 31, which depends on claim 28, Gropper discloses a UCL, which is conveyed to a recipient via various communication means (col.10, lines 57-67). Gropper fails to explicitly disclose: *said delivery service is mail delivery service*. However, Endo teaches sending a post office address for the recipient of the coupon, which is located in the upper half of the front of the card (0054, and 0137, 0141-0144, fig.27). It would have been obvious to a person of ordinary skill in the art at the time of the invention to combine Gropper, and Endo, because Endo teaches the benefit of improving the publication effect of businesses, while providing greeting cards at no cost to a sender (0005-0006).

Claims 34-36 are directed towards a method for implementing the system found in claims 30, 29, and 27 respectively, and therefore are similarly rejected.

15. Claim 37 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gropper, in view of Tackbary et al, hereinafter Tackbary (USPat.# 6,873,971 B1, 3/29/2005, filed on 3/15/2000)

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Regarding claim 37, which depends on claim 33, Gropper discloses placing personal statement, such as the motto "We make banking simple again" only on the front side of the card- (col.8 lines 1-35, col.11, lines 1-34, fig.2-D, fig.15). Gropper fails to explicitly disclose: *displaying on said web server a representation of the business communication as a user selects said business information and enters said personal expression*. However, Tackbary teaches the customization of the image of a card being displayed, by adding a message (col.11, lines 57-67, fig.8-9). It would have been obvious to a person of ordinary skill in the art at the time of the invention to combine Gropper, and Tackbary, because Tackbary teaches above customizing cards to be sent to a user as the image of the card is being displayed (0005-0006). This would provide the benefit of quickly, and effectively modify the card in a WYSIWYG environment with minimal waste of time.

Response to Arguments

16. Applicant's arguments with respect to claims 26-38 have been considered but are moot in view of the new ground(s) of rejection. The Applicant submits that neither Cannon, nor Endo teach the newly added claims (pages 7-8). The Applicants are directed towards the rejection of the newly added claims in light of the new grounds of rejection established above.

Conclusion

I. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Farros et al. (Pat. # 5,930,810 A).

II. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cesar B. Paula whose telephone number is (571) 272-4128. The

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examiner can normally be reached on Monday through Friday from 8:00 a.m. to 4:00 p.m. (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong, can be reached on (571) 272-4124. However, in such a case, please allow at least one business day.

Information regarding the status of an application may be obtained from the Patent Application Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, go to <http://portal.uspto.gov/external/portal/pair>. Should you have any questions about access to the Private PAIR system, please contact the Electronic Business Center (EBC) at 866 217-9197 (toll-free).

Any response to this Action should be mailed to:

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Or faxed to:

- (571)-273-8300 (for all Formal communications intended for entry)

12/15/05



CESAR PAULA
PRIMARY EXAMINER